

REMARKS

Summary of the Office Action

Claims 3-17 are pending in this Application. In the Office Action, the Examiner asserted that claims 10, 11, 13, and 14 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 3-17 are rejected as being unpatentable based on U.S. Patent Pub. No. 2003/0106814 to Gelardi, et al. ("Gelardi") in view of German Patent DE20008218 to Peterman GmbH & Co, KG ("Petermann").

By this response, claims 10, 11, 13, and 14 are cancelled, claims 3, 7, 8, and 12 are amended and claims 3-9, 12, and 15-17 remain under examination.

Rejection Under 35 U.S.C. § 112

Claims 10, 11, 13, and 14 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Claims 10, 11, 13, and 14 have been cancelled by this action, thereby mooting this rejection.

Rejection Under 35 U.S.C. § 103

Claims 3-17 stand rejected as being unpatentable under 35 U.S.C. § 103(a) by Gelardi in view of Petermann. The Applicants respectfully traverse this rejection.

It is well-recognized that to establish a *prima facie* case of obviousness, all the elements of the claimed invention must be disclosed by the combination of prior art references. *In re Royka*, 490 F.2d 981 (C.C.P.A. 1974). The combination of references proposed by the Examiner does not satisfy this requirement and is deficient in many aspects

Claims 3, 7, 8 and 12 have been amended to recite "the first hinge line being disposed proximate a corner of the stack bottom with the cover in a closed position." A combination of Gelardi and Petermann would not result in these features. The Examiner admits that Gelardi does not disclose a strip section. (Office Action p. 4). The Examiner states that Petermann supplies such a strip section. (Office Action p. 5). However, Petermann does not disclose that the first hinge, which joins the strip section to the cover spine, is located proximate a corner of the stack bottom with the cover in a closed position. The portion of the book jacket 8 identified by the Examiner as the strip section of Petermann would be disposed above the corner, as shown

in FIG. 1 of Petermann. This is because the strip section of Petermann appears to be of sufficient length so that the cover spine of Peterman has a width greater than the stack height. Thus, taking the strip section of Petermann and applying it to Gelardi would not result in the invention as recited in claims 3, 7, 8, and 12.

In addition to the reasons recited above, claim 12 additionally recites:

wherein with the package placed on a flat surface, and having less than half of the disc trays moved into an open position adjacent the front cover portion, the strip section remains in facing contact with and parallel to the stack bottom, and
wherein with the package placed on a flat surface, and having more than half of the disc trays moved into an open position adjacent the front cover portion, the strip section moves away from facing contact with the stack bottom.

There is no disclosure in Gelardi or Petermann to disclose such limitations. The Examiner has stated that such a limitation would be inherent or obvious from the combination of Gelardi and Petermann. There is no support for the Examiner's position. The dimensions of the strip portion must be carefully chosen in order for a package for storing discs to function as recited in claim 12. Nothing within either Gelardi or Petermann teaches or suggests how such a package may be provided. Thus, these limitations are not inherent to a combination of Gelardi and Petermann.

CONCLUSION

Applicants respectfully submit that the claims of the present Application are in condition for allowance and respectfully request an early notice of the same. Applicants further invite Examiner to contact the undersigned if the Examiner has any questions concerning this Reply, or if it will expedite the progress of this application.

Respectfully submitted,

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